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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,303	06/30/2000	Paul Lapstun	NPA050US	2504

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

COLIN, CARL G

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 03/16/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

5

Office Action Summary	Application No. 09/609,303	Applicant(s) LAPSTUN ET AL.	
	Examiner Carl Colin	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Pursuant to USC 131, claims 1-34 are presented for examination.

Specification

2. The use of the trademark MEMJET has been noted in this application in several places: for instance on page 9, page 27, page 72, line 15, and page 75, lines 21 and 23. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

- 2.1 The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

3. **Claim 13** is objected to because of the following informalities: on line 14, there is a period after the word "registration. Appropriate correction is required.

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Claims 8 and 27 are objected to because of the following informalities: there is a typo error on the word "authorisation" in claim 8 and the word "authorising" on claim 27 lines 25-26 and "authorised" on page 82 and page 83 line 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 11, 23, 29, and 30, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4.1 Regarding **claims 11, 23, 29, and 30**, the phrase "substantially invisible" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "substantially invisible"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(b).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.1 **Claims 1-34** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,081,261 to **Wolff et al.**

5.2 **As per claims 1, 13, and 15, Wolff et al.** discloses a method and system for enabling registration of a user to use a computer system, the method including: providing a printed registration form containing information relating to user registration, the form including coded data indicative of an identity of the form and of at least one reference point of the form (see column 9, line 64 through column 10, line 9; column 3, lines 25-40; and column 4, lines 7-37 and lines 52-58); receiving, in a processing system associated with the computer system, indicating data from a sensing device regarding the identity of the form and a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form, generating the indicating data using at least some of the coded data on the form (see column 9,

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line 39 through column 10, line 34; and column 6, lines 59 et seq.); and identifying, in the processing system and from the indicating data, at least one parameter relating to user registration, and storing the at least one parameter so as to be accessible by said computer system (see column 6, lines 59 et seq. and see column 9, line 39 through column 10, line 38).

As per claims 2 and 14, Wolff et al. discloses the limitation of wherein said at least one parameter relating to the user registration is associated with at least one zone of the form, and wherein the method includes identifying, in the processing system and from the zone relative to which the sensing device is located, said at least one parameter (see column 4, lines 7-37 and column 3, lines 42-65).

As per claim 3, Wolff et al. discloses the limitation of wherein the indicating data includes time varying position information regarding movement of the sensing device relative to the form which is generated by the sensing device during operation thereof using at least some of the coded data, and wherein the method includes identifying, in the processing system and from the movement information of the sensing device at least partially within said at least one zone, said at least one parameter (see column 4, lines 7-51).

As per claims 4 and 18, Wolff et al. discloses the limitation of in which the at least one parameter is a text parameter of the user registration, the method including identifying, in the processing system, that said movement information of the sensing device represents an action of entering handwritten text data by means of the sensing device and effecting, in the processing

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system, an operation associated with the text parameter (see column 4, lines 7-12 and lines 52-67 and column 8, lines 48-67)

As per claims 5 and 19, Wolff et al. discloses the limitation of including converting, in the processing system, the identified handwritten text data into computer text (see column 7, lines 6-14 and column 6, lines 31-45).

As per claim 6, Wolff et al. discloses the limitation of wherein the at least one text parameter comprises registration data identifying said user (see column 3, lines 25-50 and column 8, lines 59-67).

As per claim 7, Wolff et al. discloses the limitation of wherein the registration data includes identification and contact details associated with said user (see column 3, lines 25-50).

As per claim 8, Wolff et al. discloses the limitation in which the parameter is a user authorization parameter, the method including identifying, in the processing system, that the user has entered a handwritten signature by means of the sensing device and storing data identifying the handwritten signature so as to be accessible by the computer system (see column 8, lines 59-67 and column 7, lines 5-14).

As per claims 9 and 21, Wolff et al. discloses the limitation of which includes printing the registration form on demand (see column 6, lines 46-52).

As per claims 10, 22, 28, and 33, Wolff et al. discloses the limitation which includes printing the form on a surface-defining means and, at the same time that the form is printed, printing the coded data on the surface (see column 1, line 59 through column 2, line 2 and column 3, lines 34-53).

As per claims 11, 23, 29, and 34, Wolff et al. discloses the limitation of which includes printing the coded data to be at least substantially invisible in the visible spectrum (see column 7, lines 5-14). **Wolff et al.** discloses a writing instrument capable of using ink; using invisible does not depart from the spirit and scope of the invention disclosed by **Wolff et al.** (see column 10, lines 51-58).

As per claims 12, 17, and 32, Wolff et al. discloses the limitation of wherein the sensing device contains an identification means which imparts a unique identity to the sensing device, the method including storing the identity of the sensing device in association with the at least one parameter relating to user registration (see column 10, lines 34-38).

As per claim 16, Wolff et al. discloses the limitation of wherein the sensing device includes a marking nib (see column 7, lines 5-14).

As per claims 20 and 26, Wolff et al. discloses the limitation of wherein the at least one parameter relating to user registration includes information selected from the group of:

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identification information for the user; address information for the user; telephone details for the user; and privacy preferences for the user (see column 3, lines 25-50).

As per claims 24 and 30, Wolff et al. discloses a method and system for user registration of a computer system, the method including the steps of: providing a printed document registration form including registration information and coded data thereon, the coded data including an indication of an identity of the form and at least one reference point on the form (see column 9, line 64 through column 10, line 9; column 3, lines 25-40; and column 4, lines 7-37 and lines 52-58); receiving in the computer system indicating data from a sensing device, the indicating data including information regarding an identity of the sensing device, the identity of the form and at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data (see column 9, line 39 through column 10, line 45; and column 6, lines 59 et seq.); deriving, from the indicating data regarding at least one action of the sensing device in relation to the form, an identity of a user to be registered (see column 10, lines 34-40); and storing, in the computer system, registration data for the user including the identity of the user associated with the identity of the sensing device (see column 6, lines 59 et seq.; column 9, line 39 through column 10, line 38 and column 10, lines 34-38).

As per claims 25 and 31, Wolff et al. discloses the limitation of wherein the at least one action of the sensing device in relation to the form includes the formation of handwritten text and/or markings on the form (see column 10, lines 34-40).

As per claim 27, **Wolff et al.** discloses the limitation of including receiving in the computer system authorizing data from a second sensing device, the authorizing data including information regarding the identity of the second sensing device, the identity of the form and at least one action of the second sensing device in relation to the form generated by the second sensing device using at least some of the coded data, the second sensing device being associated in the computer system with a second user authorized to permit user registrations (see column 10, lines 34-40). **Wolff et al.** discloses multiple users and sensing device associated with each user. The same invention disclosed can be applied to multiple users.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses the use of authentication between a client and/or user and one or more servers.

US Patents:	5,247,137	Epperson
	6,088,695	Kara

6.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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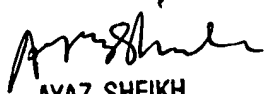
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc

Carl Colin

Patent Examiner

March 10, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100